



**MAIL STOP APPEAL
BRIEF - PATENTS**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicants: H.H. Birch et al. Attorney Docket No. EXIN116550
Application No: 09/648,581 Group Art Unit: 3627
Filed: August 25, 2000 Examiner: M. Thein
Title: SYSTEM AND METHOD FOR MATCHING AN OFFER WITH A QUOTE

APPELLANT'S REPLY BRIEF

Seattle, Washington

July 18, 2005

TO THE COMMISSIONER FOR PATENTS:

This Reply Brief is filed in response to the Examiner's Answer, mailed May 18, 2005, and pursuant to 37 C.F.R. § 1.193(b)(1).

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

REMARKS

In addition to the arguments set forth in appellants Supplemental Appeal Brief (hereafter "Appeal Brief"), please consider the following:

Regarding Related Appeals and/or Interferences

On page 2 of the Examiner's Answer, item (2), the Examiner's Answer states that appellants' Appeal Brief failed to include a statement as to whether there are any related appeals or interferences. This is not so. In fact, on page 2 of the Appeal Brief, appellants stated the following: "[u]pon information and belief, appellants do not have any knowledge of related appeals or interferences that may directly affect or have a bearing on the decision of the Board of Appeals and Interferences (hereinafter, the 'Board') in the pending Appeal."

Regarding the Grouping of the Claims

On page 3 of the Examiner's Answer, item (7), the Examiner's Answer states that all claims stand or fall together because appellants' brief failed to include a statement of a contrary groupings and reasons in support thereof. In fact, appellants explicitly identified several claim groupings on page 17 of the Appeal Brief. Furthermore, support was provided as to why they are separately patentable and should be considered as standing or falling together.

Appellants note that while the Examiner's Answer suggests that appellants failed to properly identify multiple groups of claims and support thereof, yet the Examiner's Answer explicitly acknowledged that the Appeal Brief did, in fact, set forth reasoning for separately patentable groupings. For example, in the Examiner's Answer, on page 11, second paragraph under the heading "Claim 6," the Examiner's Answer states the following: "Appellants assert that claim 6 includes additional recitations that further distinguish it from Webber, **thus claim 6 is separately patentable and stands alone.**"

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

While appellants believe that the Appeal Brief clearly and sufficiently identified separate groupings of claims and provided support thereof, appellants herein reiterate the following groupings of Claims:

- Claims 1-5 and 7-11 stand or fall together.
- Claim 6 stands or falls alone. Claim 6 recites that quotes provided by the selected preferred provider are evaluated in descending order of value, from the highest quote to the lowest, selecting the highest quote that satisfies the offer.
- Claims 12-23 stand or fall together. Claim 12 recites ranking the providers of the group of preferred providers and determining whether a quote from the selected highest ranked preferred provider satisfies the offer.
- Claims 24-27 stand or fall together. Independent Claim 24 includes elements found in both independent Claim 1 and in dependent Claim 6. Claim 24 further recites both preferred providers as well as the product which they provide.
- Claims 28-29 stand or fall together. Claim 28 recites that when turning to the non-preferred providers, the lowest quote for a product from a preferred provider is selected.

Basis For Which The Final Rejections Should Be Overturned

Response to Examiner's Answer

Claim 1

Claim 1 Positively Recites Numerous Elements Incorrectly Dismissed as

Alternatives in the Examiner's Answer

The Examiner's Answer asserts that Claim 1 includes recitations couched in "if/then" phraseology, and that when a claim covers alternatives, the claim is deemed anticipated if any alternative is known in the prior art. Assuming, of course, that all other non-alternative recitations

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

are also found in the prior art, appellants agree. However, in regard to actual alternatives, appellants disagree with the Examiner's interpretation as to what is alternative, and what is not.

The Examiner's Answer asserts that "Claim 1 positively recites matching an offer for a product received from a customer with a preferred provider selected from a group of preferred providers." (While Claim 1 includes multiple positively recited elements, appellants must point out that this quotation is the Examiner's interpretation or summary of one or more elements of Claim 1, and appellants reject it as accurately reflecting the positively recited elements of this claim.) However, the Examiner's Answer intimates that all other recitations of Claim 1 are alternatives, which is fallacious.

Claim 1 reads as follows:

"A computer-implemented method of matching an offer for a product with a quote, comprising:

at a first computer:

receiving the offer from a customer;

selecting a preferred provider from a group of preferred providers;

obtaining at least one quote for the product from the selected preferred provider;

evaluating the at least one quote from the selected preferred provider to determine if the at least one quote satisfies the offer;

if the at least one quote from the selected preferred provider does not satisfy the offer, repeatedly:

selecting another preferred provider from the group of preferred providers;

obtaining at least one quote for the product from the selected preferred provider; and

evaluating the at least one quote from the selected preferred provider to determine if the at least one quote satisfies the offer;

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

until the offer is satisfied or until the group of preferred providers is exhausted;
if the group of preferred providers is exhausted without satisfying the offer, attempting to satisfy the offer from a group of non-preferred providers; and
if the offer is satisfied from either the group of preferred providers or the group of non-preferred providers, negotiating the purchase of the product from the provider associated with the satisfying quote."

As shown above, there are thirteen "clauses" to Claim 1. In the following discussion, these clauses will be referred to as Clauses 1-13. Appellants note that indentation and clause numbering have been used in order to facilitate identification of the alternative clauses.

The preamble of Claim 1, which breaths life into the claim by adding particular context to the claim, points out that the computer-implemented method is directed at "matching an offer for a product with a quote." As will become clear below, this matching quote comes from a provider, i.e., a vendor with whom the purchase of the product can be arranged.

In regard to positively recited elements, appellants assert that Clauses 2-6 are positively recited elements of Claim 1. Appellant further asserts that Clause 7 is a positively recited element, including an decision whether to continue requesting quotes from preferred providers, i.e., "if the at least one quote from the selected preferred provider does not satisfy the offer."

Appellants acknowledge that Clauses 8-11 are executed only if the first selected preferred provider fails to satisfy the offer with a quote, as determined in Clause 7.

Clauses 12-13 are also positively recited elements of Claim 1. More particularly, appellants point out that they are not part of the "repeat ... until ..." iteration of Clauses 8-11, but separately recited elements external to the iteration, each setting forth a decision and a corresponding action.

Appellants note that Clauses 7, 12, and 13 are "if/then" clauses, each inherently, but clearly, identify a decision. Thus, while each decision, separately, may provide for alternative actions, the decisions themselves are positively recited elements. In further support, appellants note that these "if/then" clauses are listed conjunctively with Clauses 1-7 by the "and" at the end of Clause 12, not alternatively.

The Equivalence of Provider and Itinerary is Illogical and Unsupportable

As a preliminary matter, the recitation "selecting a preferred provider from a group of preferred providers" identifies a group of preferred providers. The meaning of "preferred provider" is at issue in this appeal. The Examiner's Answer, on page 6, apparently equates itineraries to providers. However, appellants submit that equating "itinerary" to "provider" is illogical and unsupportable.

With regard to Claim 1, substituting "itinerary" for "provider" in the claim (and skipping several of the elements for simplicity and legibility) we would have the following: "selecting a preferred *itinerary* from a group of preferred *itineraries* ... and ... negotiating the purchase of the product from the *itinerary* associated with the satisfying quote." Clearly, it is absurd to assert that one can negotiate the purchase of a product from an itinerary. Webber, U.S. Patent No. 5,331,546, the primary cited reference, certainly fails to disclose such absurdity. Yet if the equivalence of provider and itinerary is sustained, that is exactly how these claims must be construed. Appellants assert that this equivalence is illogical and unsupported in Webber.

The Examiner's Answer's equivalence of "provider" and "itinerary" is also unsupportable in light of the fact that Claim 1 obtains quotes from a provider **for a product**. A product, as the claim suggests, is something that can be purchased. An itinerary would logically be construed as a product, not a provider, as one can purchase an itinerary from a provider. Thus, as Claim 1

recites both a product and a provider, the only logical equivalence that could be made is equating "itinerary" to "product."

Additionally, the equivalence of "provider" to "itinerary" is clearly contrary to the plain meaning of the term "provider," as well as the meaning of "provider" in light of its clear use throughout the specification and in the claims. More particularly, providers are entities, such as vendors, who can provide or sell the sought-for product, the subject matter of the offer from the consumer.

In sum, the Examiner's Answer's assertion that "provider" and "itinerary" as equivalent is illogical, is unsupported by any disclosure of Webber, and is contrary to the plain meaning of the term and its clear using the specification and the claims.

Webber Fails To Disclose Each Positively Recited Element of Claim 1

Appellants assert that Webber fails to disclose each positively recited element of Claim 1.

In particular, Webber fails to disclose the following:

- "selecting a preferred provider from a group of preferred providers;
- "obtaining at least one quote for the product from the selected preferred provider;
- "evaluating the at least one quote from the selected preferred provider to determine if the at least one quote satisfies the offer;
- "if the at least one quote from the selected preferred provider does not satisfy the offer, repeatedly:
- "if the group of preferred providers is exhausted without satisfying the offer, attempting to satisfy the offer from a group of non-preferred providers; and
- "if the offer is satisfied from either the group of preferred providers or the group of non-preferred providers, negotiating the purchase of the product from the provider associated with the satisfying quote."

In regard to *"selecting a preferred provider from a group of preferred providers,"* the Examiner's Answer maintains the flawed assertion that itineraries are the functional equivalent of providers, and that selecting an itinerary from a selected small set of candidate itineraries constitutes *"selecting a preferred provider from a group of preferred providers."* However, as discussed, itineraries cannot reasonably be construed as the equivalent of a provider. As such, appellants assert that Webber fails to disclose *"selecting a preferred provider from a group of preferred providers."*

In regard to *"obtaining at least one quote for the product from the selected preferred provider,"* this positively recited element also illustrates the fallacy of equating itineraries with providers. More particularly, the Examiner's Answer asserts that searching the selected candidate itineraries from which a user can select one is considered *"obtaining at least one quote for the product from the selected preferred provider."* In other words, the logic of the Examiner's Answer suggests obtaining a quote from the preferred provider/itinerary for the product/itinerary. Clearly, this is an unreasonable distortion of the clear and plain meaning of the recitation *"obtaining at least one quote for the product from the selected preferred provider."* Indeed, Webber utterly fails to disclose *"obtaining at least one quote for the product from the selected preferred provider"* as the rational meaning of the language suggests.

In regard to *"evaluating the at least one quote from the selected preferred provider to determine if the at least one quote satisfies the offer,"* appellants assert that Webber fails to disclose this element. The Examiner's Answer apparently asserts that the selected itineraries are presented to a travel arranger so that the travel arranger can decide if their cost is attractive enough to take action. In other words, the Examiner's Answer clearly admits that it is a user/human that evaluates whether an itinerary's cost is attractive enough to take action. This, of course, means that Examiner's Answer admits that Webber fails to disclose a

computer-implemented method that, *inter alia*, "evalut[es] the at least one quote from the selected preferred provider to determine if the at least one quote satisfies the offer," as recited in Claim 1.

With respect to the recitation "*if the at least one quote from the selected preferred provider does not satisfy the offer, repeatedly*:", appellants assert that this is a positively recited element of the claim, and is not an alternative which can be ignored. This recitation includes a determination whether or not the consumer's offer was satisfied by a quote from the first selected preferred provider, as well as establishing the beginning ("repeatedly:") of actions to take if it was not. Appellants acknowledge that some of the following actions are the alternatives if the offer is not satisfied, but the determination itself (the "if" clause) is not.

The Examiner's Answer is silent as to a determining whether the quote satisfies the offer and commencing alternative actions if the quote does not satisfy the offer. Appellants assert that Webber fails to disclose this element.

With respect to "*if the group of preferred providers is exhausted without satisfying the offer, attempting to satisfy the offer from a group of non-preferred providers*," appellants assert that this is a positively recited element (not an alternative as the Examiner's Answer asserts), and that Webber fails to disclose this element. The Examiner's Answer relies upon its earlier assertion that itineraries as providers, suggesting that Webber discloses turning to non-preference itineraries if the preference itineraries are exhausted. However, as already discussed, itineraries cannot be reasonably construed as providers. Thus, it is not relevant whether or not Webber discloses turning to non-preference itineraries, because they do not represent a group of non-preferred providers.

With respect to the element "*if the offer is satisfied from either the group of preferred providers or the group of non-preferred providers, negotiating the purchase of the product from*

the provider associated with the satisfying quote," appellants assert that this is clearly not an alternative element (the "if" clause is executed whether or not the offer is satisfied), and that Webber fails to disclose this element.

The Examiner's Answer is silent with regard to this element. However, as indicated above, equating itinerary with provider transforms the clearly understandable element into nonsense. More particularly, the assertion that itinerary is equated to provider transforms this element to read: "if the offer is satisfied from either the group of preferred *itineraries(providers)* or the group of non-preferred *itineraries(providers)*, negotiating the purchase of the *itinerary(product)* from the *itinerary(provider)* associated with the satisfying quote." Webber does not disclose any such element.

Webber Fails To Disclose Each Recited Element of Claim 1 Identified By the
Examiner's Answer as Alternative Elements

The Examiner's Answer asserted that the following elements are disclosed by Webber:

"repeatedly:

"selecting another preferred provider from the group of preferred providers;

"obtaining at least one quote for the product from the selected preferred provider; and

"evaluating the at least one quote from the selected preferred provider to determine if the at least one quote satisfies the offer;

"until the offer is satisfied or until the group of preferred providers is exhausted;

These elements are similar to those described above except for "selecting another provider from the group of preferred provides." Furthermore, the Examiner's Answer asserts that the same reasoning, specifically that itineraries are the functional equivalent to providers, is applicable. However, as discussed above appellants assert that equating itineraries to providers

renders the claim incomprehensible, and violates the plain meaning of the language. In fact, Webber fails to disclose the elements cited above.

Webber Fails To Anticipate Claim 1

The Examiner's Answer asserts that itineraries is the functional equivalent of providers, and as such, Webber discloses each and every element of Claim 1 (both positively recited and alternative elements.) However, as pointed out above, equating itinerary to provider violates the clear meaning of the term provider as well as the clear usage of the term in the specification. Similarly, equating itinerary to provider reduces the clear language of the claims to nonsense. As those skilled in the art will certainly appreciate, an itinerary may be viewed as a product, certainly not as a product provider. In this light, Webber clearly fails to disclose each element of Claim 1.

It is well established that a claim is anticipated only if each and every element of the claim is found, either expressly or inherently described, in a single prior art reference. *See, Verdegaa Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 60 USPQ2d 1051, 1053 (Fed. Cir. 1987). Accordingly, appellants submit that Webber fails to anticipate Claim 1, and that the rejection of Claim 1 as being anticipated by Webber is improper and should be overturned.

Claim 6

Claim 6 includes recitations that further distinguish it from Webber. In particular, Claim 6 recites "*evaluating the quotes provided by the selected preferred provider in descending order of value, from the highest quote to the lowest quote, and selecting the highest quote that satisfies the offer.*"

In the first case, as already discussed above, it is unreasonable to equate "itinerary" with "provider". If not so, as the Examiner's Answer suggests, this recitation would read: "evaluating the quotes provided by the selected preferred *itinerary(provider)* in descending order of value." Clearly, all would concede that you cannot obtain quotes (i.e., plural) from an itinerary item for purchase.

Even assuming the absurdity of "itinerary" as "provider," Claim 6 further recites "*evaluating quotes in descending order of value, from the highest to the lowest, and selecting the highest quote that satisfies the offer.*" Clearly this suggests that there are lower quotes that satisfy the offer, but the highest quote that satisfies the offer is selected. Webber suggests quite the opposite, namely, finding the lowest priced itinerary (air fare) that satisfies the consumers needs. Offering a higher priced itinerary that satisfies the offer is a violation of Webber's teachings.

In sum, for the same reasons discussed above, particularly that "itinerary" cannot logically or rationally be equated to "provider," Webber fails to disclose each positively recited element of Claim 6. Furthermore, Claim 6 includes additional elements such that is separately patentable from Claim 1 and that are not found in Claim 1. Appellants request, therefore, that the Board overturn the 35 U.S.C. § 102(a) rejection, and allow the claim.

Claims 12-23

In addition to elements common with Claim 1, independent Claim 12 includes additional recitations that are not found in Claim 1 that distinguish this claim as separately patentable from Claim 1. In particular, Claim 12 recites the following:

"ranking each preferred provider in a plurality of preferred providers according to a preferred criteria;"

"selecting a highest ranked preferred provider from the plurality of preferred providers;" and

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

"attempting to match the offer from the customer with the highest ranked preferred provider by determining whether a quote obtained from the highest ranked preferred provider satisfies the preferred criteria associated with the highest ranked preferred provider."

The Examiner's Answer again suggests equating itinerary with provider. As discussed above, such equivalence cannot be reasonably made. As such equivalence is not reasonable, appellants assert that Webber fails to disclose ranking preferred providers, selecting the highest ranked provider, and determining whether a quote from the highest ranked provider satisfies the offer.

Claims 24-27

In addition to asserting that it is unsupportable to equate "itinerary" with "provider" (for the various reasons as described above), Claim 24 recites that there are two distinct groups of providers, the preferred group being ranked with a distinct preference ranking. Appellants assert that this information, while identifying this claims as separately patentable from Claim 1, is not disclosed by Webber.

Claims 28-29

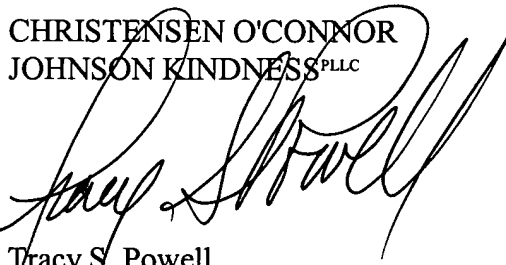
In addition to asserting that it is unsupportable to equate "itinerary" with "provider" (for the various reasons as described above), Claim 28 recites evaluating quotes from non-preferred providers and selecting the lowest quote that satisfies the offer. Appellants assert that this information, while identifying this claims as separately patentable from Claim 1, is not disclosed by Webber.

CONCLUSION

In view of the foregoing remarks, as well as appellant's Appeal Brief, appellants submit that pending Claims 1-29 are in condition of allowance. Therefore, it is submitted that the Examiner's rejections of Claims 1-29 were in error. A reversal of the Examiner's rejections, and allowance of the claims, is respectfully requested.

Respectfully submitted,

CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}



Tracy S. Powell

Registration No. 53,479

Direct Dial No. 206.695.1786

I hereby certify that this correspondence is being deposited in triplicate with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the below date.

Date: July 18, 2005

Lorinda Lewis

TSP:lal

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100